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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,750	01/27/2004	Geoffrey B. Rhoads	P0925	3644

23735 7590 04/29/2005

DIGIMARC CORPORATION
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EXAMINER

COUSO, JOSE L

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/766,750	Applicant(s) RHOADS, GEOFFREY B.	
	Examiner Jose L. Couso	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The examiner's objection of the reissue oath/declaration filed with this application asserting that it was defective because it failed to identify at least one error which is relied upon to support the reissue application, has been reviewed in light of applicant's comments. The examiner is withdrawing the objection.

2. The rejection of claims 1-18 as being based upon a defective reissue declaration under 35 U.S.C. 251 is withdrawn.

3. Claims 1-18 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The amendment filed January 27, 2004 proposes amendments to the appendix B (by way of compact disc, as stated on page 3, lines 1-4 and on page 10, lines 12-18). It is unclear to the examiner whether 1) this additional subject matter ("plug-in") was part of the original patent specification and 2) the latest version of the software is a new version containing additional subject matter.

There appears to be no support in the original patent specification for these amendments. Applicant should clearly state where support is found in the specification for these newly proposed amendments.

Applicant should clearly state what differences, if any, exist between the original Appendix B and the proposed amended Appendix B.

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Applicant should also come with a statement that the Appendix contains no new matter, and that the proposed Appendix B is the same and exact Appendix as originally filed, if that is indeed the case.

This is necessary in order for the examiner, and the record, to ascertain exactly what is being changed in the current reissue application.

4. Claims 1-18 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. Claims 1-18 are broader in scope in light of the new amendments to the specification, in column 1, line 19 and at column 90, line 61, namely the amendment "duplicate copies of a compact disc with a file entitled "Appendix B.txt" and "Applicant is preparing a steganographic marking/decoding "plug-in" for use with Adobe Photoshop software. The latest version of the software, presented as commented source code, is included in the file of this patent on a compact disc in a file named Appendix B.txt created on January 27th, 2004 ... The code was written for compilation with Microsoft's Visual C++ compiler, version 4.0, and can be understood by those skilled in the art". A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

5. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

6. Applicant's arguments filed November 22, 2004 have been fully considered but they are not persuasive.

The examiner has reviewed applicant's arguments on pages 3-4 of the response, the examiner however respectfully disagrees.

While the examiner would have no problem entering the same exact Appendix as found in the original application, the newly presented amendments to the specification appear to present an Appendix that is different from the Appendix in the original specification. The new amendments to the specification, namely "duplicate copies of a compact disc with a file entitled "Appendix B.txt" and "Applicant is preparing a steganographic marking/decoding "plug-in" for use with Adobe Photoshop software. The latest version of the software, presented as commented source code, is included in the file of this patent on a compact disc in a file named Appendix B.txt created on January 27th, 2004 ... The code was written for compilation with Microsoft's Visual C++ compiler, version 4.0, and can be understood by those skilled in the art" add material that was never present in the original specification and appears to add material to the newly presented Appendix.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jose L. Couso whose telephone number is (703) 305-4774. The examiner can normally be reached on Monday through Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached on (703) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the USPTO contact Center whose telephone number is (703) 308-4357.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jlc
April 19, 2005



JOSE L. COUSO
PRIMARY EXAMINER